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EXAMINER	
SRIVASTAVA, VIVEK	

ART UNIT	PAPER NUMBER
2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/449,016	Applicant(s) KAMEN ET AL.	
	Examiner Vivek Srivastava	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant argues, in regards to claims 1 and 11, that Broadwin fails to disclose overlaying the main program screen which continues to provide it's original information even after the user changes the channel or starts some other task, fails to disclose a banner advertisement and fails to disclose a counter (see page 14 of response).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the features discussed above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues, in regards to claim 8, Sibecas in no way teaches changing the subject matter of the video screen window when the user changes channels on the TV (see page 17 of response).

The Examiner respectfully submits that Sibecas introduced to teach displaying a prompt throughout the duration of the commercial. Applicant's invention is directed to displaying a commercial window for a duration of the commercial to ensure the viewer is not lost when the channel is changed.

Sibecas was not introduced to teach chaning the subject matter of the video screen window when the user changes channels. As far as the channel changing limitation, this is met Broadwin by accessing a still image channel after watching the television content on another channel (see col 10 lines 48-57). As result, Applicant's arguments are not persuasive.

Applicant argues, in regards to claim 19, the time duration sent in Applicant's invention is very different from that disclosed in Hymel, in which a time is sent to dictate how long an advertisement is do displayed on a cell phone. Additionally, in Hymel, the timer is not disclosed to the cell phone user (see page 19 of response).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the time duration sent in Applicant's invention is used to inform the user of the remaining time until the main program begins again and the timer is not disclosed to the cell phone user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues, in regards to claim 20, that neither Sibecas nor Hymel suggest combining technologies in order to anticipate Applicant's invention by

applying their own technologies to the field of Applicant's invention (see page 20 of response).

The Examiner has considered Applicant's point and respectfully disagrees. It would have been obvious to one skilled in the art to combine the technologies to anticipate Applicant's invention. As a result, the Applicant's arguments are not persuasive.

Applicant argues, in regards to claims 30, 34, and 37 implementing a tracking method of broadcast TV advertising in neither simple, nor obvious, in view of tracking advertising over the internet. Applicant further takes notice that at no point in the Davis application does the inventor teach or suggest any applicability of the tracking technology disclosed therein to a one-way communicative network such as broadcast television (see page 21 of response).

The Examiner respectfully disagrees and maintains it would have been obvious to combine the references. The Examiner further notes that tracking technology is possible in a one-way communicative network by including a separate network for communicating tracking data upstream from user site to the headend.

Applicant argues, with respect to claim 33, the Examiner has taken "Official Notice" but fails to cite any evidence that such technology was known in the art at the time of the invention.

The Examiner cites Bauminger et al (6,681,393) to support the Official Notice taken. In particular, Bauminger teaches rewarding a user for watching advertisements (see page 5 lines 33-39). If Applicant's are not satisfied with this reference, the Examiner can cite further references upon request.

The Examiner suggests Applicant's to set up an interview with the Examiner to discuss this application as the Examiner feels that proper language recited in the claims should expedite prosecution to allowance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 – 6, 9, 11, 14, 15, 17, 18, 22, 24 – 27, 29, 31, and 36 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Broadwin (5,929,950).

Considering claims 1, 11, 17, 25, 36, 38, 39 and 42 Broadwin discloses displaying a AV television commercial on a video screen (col 9 lines 35 – 67, col 6 lines 50 – 60), noting that a television program comprises a segment.

Broadwin also discloses that the viewer has the option of enabling thumbnail still images to display additional information (see col 9 lines 35 – 66, and col 17 lines 39 – 42) and thus discloses no longer displaying the television program by changing the subject matter displayed. Broadwin further discloses a window region continuing to display an indication of the television program segment (col 10 lines 48 – 55). Broadwin further discloses circuitry (met by antenna 120 and interactive decoder 140 see fig 10) for receiving a AV broadcast signal from a first source, i.e., broadcast center 100 (fig 10) and circuitry for receiving still images from a second source, i.e., media server 180 (fig 10 and col 12 lines 54 – 65). Broadwin further discloses the claimed video screen displaying a window indicating that the segment is being provided to the circuitry while the video screen displays the other visual information (col 10 lines 48 – 55). Broadwin also discloses that the user can turn on or off the still image window and return to viewing the AVI television commercial thus without disturbing the content being display on the rest of the video screen and thus discloses a means to cease displaying the small window or banner (see col 15 lines 49 – 53). Broadwin further discloses an additional window which sets forth a banner advertisment (met by commercial segment in col 9 lines 35-57, col 6 lines 50-60). It is noted that because of the alternative statement "or" (claim 17), Broadwin is required to meet one of the two limitations. It should be noted that the window or banner remains on the screen while the user performs other tasks i.e. observer still web images.

Considering claims 3, 4, 6, Broadwin discloses the window region is a commercial advertising products, wherein the window is a product advertised during a commercial (see col 9 lines 45 – 65, Sun SparcStation computer commercial advertises related products including modem, laptop computer, video monitor etc).

Considering claims 5, 14, 18, 26, Broadwin discloses that the segment is a commercial (col 9 lines 35 – 67, col 6 lines 50 – 60).

Considering claim 9, Broadwin discloses the claimed wherein link is associated with window region and invoking the link (see col 16 lines 20 – 37, col 15 lines 20 – 38).

Considering claim 15, Broadwin discloses the interactive selection options are overlaid on top of the still image window (see col 16 lines 30 – 37) and thus discloses the claimed link being associated with the banner so that the a viewer can click on the banner.

Considering claim 22, Broadwin discloses linking one banner with another being broadcast and thus discloses the claimed "additional window includes a link (see col 16 lines 20 – 37).

Considering claim 24, Broadwin discloses providing image stills corresponding to the advertisement of Sun SparcStation from a first source (see col 9 lines 58 – 65) and thus discloses the claimed limitation.

Considering claim 27, Broadwin discloses transmitting information with links banners or image stills to one another which executable by a user (see col 10 lines 20 – 37) and thus discloses the claimed limitation.

Considering claim 29, Broadwin discloses a TV program or segment, noting that a program segment inherently comprises a plurality of commercials. Broadwin further discloses that the still image banners are products related to the commercial, i.e., banners advertising a modem, laptop computer, video monitor are related to Sun SparcStation (see col 9 lines 58 – 65) and thus change with each commercial since they are related to each commercial. Therefore, Broadwin discloses the claimed "wherein said segment comprises a plurality of commercials, and said banner changes as said commercials change".

Considering claim 31, Broadwin discloses the claimed windows or banners are provided to video systems as part of a television broadcast (see col 10 lines 48 – 57).

Considering claim 37, Broadwin discloses the claimed remote control (see col 5 lines 64 – 67, col 9 lines 15 – 30).

Regarding claims 40 and 41, Broadwin discloses "If the user is currently viewing still image and the selection indicates a desire to return to viewing the video content of the AVI signal, i.e., to return to watching the television program or commercial being presented..." (see col 15 lines 49-54) noting that the user makes a selection by sending a signal to the video system to cease displaying the still image window.

Considering claim 43, Broadwin discloses a selection means which sends a signal to the video system to cease displaying the small window or banner showing (see col 15 lines 49 – 53).

Considering claim 44, Broadwin discloses "If the user is currently viewing a still image and the selection indicates a desire to return to viewing the video content of the AVI signal, i.e., to return to watching the television program or commercial being presented..." and thus discloses the claimed "second means causes the video screens to cease displaying the small window or banner during commercials".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin in view of Sibecas et al (6,167,235).

Considering claim 2, Broadwin fails to disclose the claimed modifying what is displayed in the window region when the segment is over.

Sibecas teaches displaying a prompt which indicates additional information is available for the commercial and teaches the prompt is shown at the beginning of the commercial and is retained in the commercial until the end of the commercial (see col 3 lines 40 – 43). It would have been obvious to modify what is displayed in the window region when the segment is to prevent displaying additional information related to the commercial since the commercial for which

the additional information is for would have been over. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Broadwin to include the claimed limitation to prevent displaying additional information for the commercial segment when the commercial segment is over.

Considering claim 8, Broadwin fails to disclose the claimed wherein changing the subject matter comprises viewing another channel on the video screen.

Sibecas teaches displaying a prompt which indicates additional information is available for the commercial and teaches the prompt is retained in the commercial till the end of the commercial (see col 3 lines 40 – 43) or as long as the commercial is displayed. It would have been obvious to one skilled in the art to modify Broadwin to include the claimed changing the subject matter comprises viewing another channel to prevent viewing of additional information of a given commercial if the given commercial is not longer displayed as result of a channel change.

Claims 7, 10, 16, 21, 23, 28, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin in view of Kikinis (5,929,849).

Considering claim 7, Broadwin fails to discloses wherein the changing of subject matter comprises using the video screen to access the Internet. Kikinis teaches an interactive television system which changes the subject matter

displayed by displaying additional information retrieved from a web page on the WWW via the Internet and teaches that the Internet provides access to an abundance of information (see col 8 lines 23 – 37). It would have been obvious to modify Broadwin to include the claimed limitation to provide a user with access to an abundance of information.

Regarding claims 10, 16, 21 and 28 Broadwin fails to disclose the claimed wherein link is to a web page. Kikinis teaches an interactive television system which changes the subject matter displayed by displaying additional information retrieved from a web page on the WWW via the Internet and teaches that the Internet provides access to an abundance of information (see col 8 lines 23 – 37). It would have been obvious to modify Broadwin to include the claimed limitation to provide a user with access to an abundance of information.

Considering claim 23, Broadwin fails to disclose the claimed URL. Kikinis teaches an interactive television system providing links to other web pages by invoking URLS (col 7 lines 48 – 67) and that a link to Internet and Web pages provides a user with an abundance of information (see col 8 lines 23 – 37). It would have been obvious to one skilled in the art to modify Broadwin to include the claimed URL linking to the Internet to provide the user with an abundance of information.

Considering claim 45, Broadwin discloses displaying a video program on a video screen and displaying one or more small windows on said video screen during video program (see col 9 lines 36 – 63, col 10 lines 53 – 57). It should be

noted that the window or banner remains on the screen while the user performs other tasks i.e. observer still web images.

Broadwin fails to disclose the claimed adjusting the position and/or location of the one or more small windows or banners, wherein the position and/or location of the one or more small windows or banners is accomplished by the viewer.

Kikinis teaches a viewer can adjust the location of a web page window on a screen (see col 8 lines 1 – 10). It would have been obvious modifying Broadwin to include the claimed limitation would have provided a better interactive experience for the viewer and would have enabled the viewer to move the display window to a desired location. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kikinis to include the claimed limitation to provide a better interactive experience for the viewer while enabling a user to more the window to a desired more pleasing location.

Considering claim 46, Broadwin discloses a TV for displaying a video program (see TV 150 in fig 1) and discloses circuitry for receiving a signal corresponding to one or more small windows or banners to be displayed on the video screen (note circuitry is inherently included since the thumbnail image windows are received and displayed, see col 9 lines 35 – 63 and col 17 lines 35 – 42). It should be noted that the window or banner remains on the screen while the user performs other tasks i.e. observer still web images.

Broadwin fails to disclose the claimed control device for permitting a viewer to adjust the size and location of the one or more small windows or banners.

Kikinis teaches a viewer can adjust the size of the web page window (see col 8 lines 5 – 10) on a display screen. It would have been obvious modifying Broadwin to include the claimed limitation would have provided a better interactive experience for the viewer and would have enabled the viewer to adjust the window to the size desired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kikinis to include the claimed limitation to provide a better interactive experience for the viewer while enabling a user to adjust the size of the window as desired.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin.

Considering claims 12 and 13, Broadwin fails to disclose the claimed wherein the additional signal information to be displayed is included in a portion of a video signal that does not normally contain visual information or the blanking interval. The Examiner Takes Official Notice it would have been well known to modify Broadwin to include the claimed limitation to efficiently transmit data during the VBI when no visual data is being transmitted.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin in view of Hymel et al (6,157,814).

Regarding claim 19, Broadwin fails to disclose the claimed wherein the video signal comprises a time marker indicating the time duration of the commercial in said additional window.

Hymel teaches including advertisement duration information in a signal transmitted with advertisements ensures advertisements are displayed and provides information desired by advertisers (see col 1 line 64 – col 2 line 34). The Examiner takes Official Notice it would have been well known in the art to include a time marker in a window to indicate the timing of program or the time left in a program. It would have been obvious to one having routine skill in the art to modify Broadwin to include the claimed subject matter to ensure advertisements are displayed and to provide information which is desired by advertisers and users including the time of a program or the time remaining in a program.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin in view of Hymel et al (6,157,814), as applied to claim 19 above, and further in view of Sibecas et al (6,167,235).

Considering claim 20, the combination of Broadwin and Hymel fails to disclose the claimed said video system includes means for determining when the commercial is over and thereafter resumes displaying the video signal.

Sibecas teaches displaying a prompt which indicates additional information is available for the commercial and teaches the prompt is retained in the commercial till the end of the commercial (see col 3 lines 40 – 43) or as long

as the commercial is displayed. It would have been obvious to one skilled in the art to modify Broadwin to include the claimed means for determining to determine when the commercial is over and thereafter resume displaying the video signal prevent displaying the additional information related to the commercial when the commercial is not longer displayed.

Claims 30, 32 – 35, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (5,929,850) in view of Davis (6,138,155).

Considering claim 30, Broadwin discloses providing thumbnail window images to one or more viewers to be displayed on a video screen (see col 9 lines 35 – 63, col 17 lines 35 – 42). Broadwin fails to disclose the claimed tracking the amount of time windows are displayed on the screen.

Davis teaches tracking how long a user displays a web page provides information as to which web pages a user finds interesting and also helps advertisers determine the effectiveness of their advertising (see col 12 line 58 – col 13 line 24). It would have been obvious modifying Broadwin to include the claimed limitation would have determine which web pages a user finds interesting and would also help advertisers determine the effectiveness of their advertising.

Considering claim 32, Broadwin discloses the claimed wherein the one or more small windows or banners display advertisements (see col 9 lines 35 – 63 and col 17 lines 35 – 42).

Regarding claim 33, Broadwin fails to disclose the claimed compensating a viewer for leaving the one or more banners on a screen based on tracking. The Examiner Takes Official Notice it would have been well known in the art to compensate viewers for watching advertisements to benefit both a viewer and an advertiser by providing a viewer with an incentive for viewing an advertisement and thus ensuring advertisers that their ads are viewed.

Considering claim 34, Broadwin discloses a transmitter for transmitting a signal containing one or more windows or banners to a set of viewers (see col 12 lines 54 – 65) but fails to disclose the claimed communicating a channel for communicating whether one or more windows or banners are being displayed on a video screen and a memory for tracking whether one or more banners are being displayed on the video screen.

Davis teaches a client device which tracks which ad windows are displayed and for how long and transmits this information to a server via a communication channel, noting that a memory is inherently included in the client device for collecting the data and that a memory is inherently included in the server device for storing the information. Davis further teaches tracking how long a user displays a web page provides information as to which web pages a user finds interesting and also helps advertisers determine the effectiveness of their advertising (see col 12 line 58 – col 13 line 24). It would have been obvious modifying Broadwin to include the claimed limitation would have determine which web pages a user finds interesting and would also help advertisers determine the effectiveness of their advertising.

Regarding claim 35, see claim 34.

Claim 47 is met by that discussed above.

Regarding claim 48, the combination of Broadwin and Davis discloses the claimed subject matter, wherein Davis inherently discloses a memory for storing the tracking data which meets the claimed "electronic memory device" limitation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sawyer (6,084,628) – providing targeted advertising during a video phone call

Collins-Rector et al (6,188,398) – Targeting advertising using web pages

Ballard (6,182,050) – Target advertising distributed on line

Hooks et al (6,169,542) – Delivering advertising through an interactive system

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872 - 9314, (for formal communications intended for entry)

Or:

(703) 308- 5399 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305 - 4038. The examiner can normally be reached on Monday - Thursday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andy Faile, can be reached at (703) 305 - 4380.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the group receptionist whose telephone number is (703) 305 - 3900.

VS

4/12/07

VIVEK SRIVASTAVA
PRIMARY EXAMINER